

### **REMARKS**

This responds to the Office Action mailed on October 9, 2007.

Claim 1 is amended. Claims 13 and 25-30 were previously canceled. Claims 1-12, 14-24 and 31-36 remain pending in this application.

#### **§103 Rejection of the Claims**

Claims 1, 2, 4, 5, 7, 10-12, 14, 15 and 17-19 were rejected under 35 USC § 103(a) as being unpatentable over Jacobson et al. (U.S. 6,517,995) in view of Suda et al. (U.S. 4,731,855) and Kamieniecki et al. (U.S. 5,661,408).

The Office Action cites to an Office Action mailed on July 27, 2006 for reference for which Jacobson is applied. The Office admits therein Jacobson fails to teach in-situ testing the substrate while attached as part of an array of substrates. Applicant agrees.

The Office was previously asked to kindly provide references to teach what Jacobson admittedly fails to teach. To that end, the Office has proffered Suda and Kamieniecki. But these references have nothing to do with what is claimed. The disconnect lies between Jacobson and the Suda and Kamieniecki references, where Jacobson's technology if applied to either of Suda or Kamieniecki, would destroy such inventions. Further, the "substrate" of Jacobson is not the "substrate" of either of Suda or Kamieniecki. Consequently, merely that of either of Suda or Kamieniecki may teach testing of their substrates, fails to show a teaching or suggestion to combine their technologies with Jacobson. Further, Jacobson would not look to either of Suda or Kamieniecki to solve any technical challenges or fields of endeavor. Withdrawal of the rejections is respectfully requested.

Claims 1, 2, 4-12, 14-20 and 31-36 were also rejected under 35 USC § 103(a) as being unpatentable over Carter (U.S. 6,730,617) in view of Suda et al. and Kamieniecki et al.

The Office admits that "Carter fails to teach in situ testing the substrate while attached as part of an array of substrates." Applicant agrees. To that end, the Office has proffered Suda and Kamieniecki. But these references have nothing to do with what is claimed. Similarly to the above rejection involving Jacobson, the disconnect lies between Carter and the Suda and

Kamieniecki references, where Carter's technology if applied to either of Suda or Kamieniecki, would destroy such inventions. Further, the "substrate" of Carter is not the "substrate" of either of Suda or Kamieniecki. Consequently, merely that of either of Suda or Kamieniecki may teach testing of their substrates, fails to show a teaching or suggestion to combine their technologies with Jacobson. Further, Carter would not look to either of Suda or Kamieniecki to solve any technical challenges or fields of endeavor. Withdrawal of the rejections is respectfully requested.

Claims 3, 6, 20 and 31-33 were also rejected under 35 USC § 103(a) as being unpatentable over Jacobson et al. in view of Suda et al. and Kamieniecki et al., and further in view of Bulthaup et al. (U.S. 6,936,181).

The above traversal involving the combination of Jacobson with either of both or Suda or Kamieniecki is incorporated herein by reference. The Office again refers to Paragraph 10 of a previous Office Action that admits "Jacobsen et al fail to teach in situ testing the substrate while attached as part of an array of substrates." Applicant agrees. But Bulthaup also fails to teach this limitation. Because all the claim limitations are not taught by the cited references, withdrawal of the rejections is respectfully requested. (M.P.E.P. § 2143 8<sup>th</sup> Ed, Rev.4).

Claim 3 was also rejected under 35 USC § 103(a) as being unpatentable over Jacobson et al. in view of Suda et al. and Kamieniecki et al./Carter, and further in view of Walter (US 4099913).

The above traversal involving the combination of Jacobson with either of both or Suda or Kamieniecki is incorporated herein by reference. The Office refers to Paragraph 9 of a previous Office Action that admits "Jacobsen et al fail to teach in situ testing the substrate while attached as part of an array of substrates." Applicant agrees. The Previous Office Action also admits "Jacobson fails to teach in situ testing the substrate while attached as part of an array of substrates." Applicant agrees. But Walter also fails to teach this limitation. Because all the claim limitations are not taught by the cited references, withdrawal of the rejections is respectfully requested. (M.P.E.P. § 2143 8<sup>th</sup> Ed, Rev.4).

Claims 6, 8, 9, 16, 20, 31, 32 and 34-36 rejected under 35 USC § 103(a) as being unpatentable over Jacobson et al. in view of Suda et al. and Kamieniecki et al., and further in view of Carter.

The above traversals involving the combination of either of Jacobson or Carter with either of both or Suda or Kamieniecki are incorporated herein by reference. The Office refers to a previous Office Action that admits “Jacobsen et al fail to teach in situ testing the substrate while attached as part of an array of substrates.” Applicant agrees. The Office also refers to a previous Office Action that admits “Carter et al fail to teach in situ testing the substrate while attached as part of an array of substrates.” Applicant agrees.

This rejection represents an aggregation of references that fail to teach or suggest the limits of the claims. Jacobson in view of Suda or Kamieniecki fail to teach what is claimed since combination of the references results in one meaning of “substrate” (e.g. Jacobson’s substrate) that is repugnant to either of Suda or Kamieniecki’s substrate. Carter in view of Suda or Kamieniecki fail to teach what is claimed since combination of the references results in one meaning of “substrate” (e.g. Carter’s substrate) that is repugnant to either of Suda or Kamieniecki’s substrate.

Because all the claim limitations are not taught by the cited references, withdrawal of the rejections is respectfully requested. (M.P.E.P. § 2143 8<sup>th</sup> Ed, Rev.4).

### **RESERVATION OF RIGHTS**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant’s silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or

assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request joinder of any withdrawn claim, as required by MPEP § 821.04.

### **CONCLUSION**


Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((801) 278-9171) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By /  /  
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